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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,240	07/09/2003	Christopher Russell Byrne		2846

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EXAMINER	
LAYNO, BENJAMIN	
ART UNIT	**PAPER NUMBER**
3711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/617,240	BYRNE, CHRISTOPHER RUSSELL	
	Examiner	Art Unit	
	Benjamin H. Layno	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Certain steps recited in disclosed claims 16-19 (copied from claims 1-4 of U.S. Patent No. 6,416,408) are not supported by the specification of the present invention (U.S. Patent No. 5,830,063). Claims 16-19 recite the step of "allocating a **multiplier value** to the group participation wagering game, said multiplier value allocated from a **plurality of multiplier values**". There is no recitation and/or support for this step in the specification of the present invention.

Also claims 16-19 recite the step of "each entrant in the group participation wagering game who achieved a winning outcome in the individual participation wagering game is guaranteed to have said **multiplier applied to said individual prize amount**". There is no recitation and/or support for this step in the specification of the present invention.

Also claims 16-19 recite the step of "determining a total prize amount for each said entrant wherein each said entrant's total prize amount is equal to said entrant's individual prize amount **multiplied by said multiplier value**". There is no recitation and/or support for this step in the specification of the present invention.

It is not clear why the Applicant is attempting to provoke an interference in this case. It is clear from the Examiner's position that claims 1-4 in U.S. Patent No. 6,416,408 are different in scope and not supported by the specification of the present invention (U.S. Patent No. 5,830,063).

Double Patenting

3. Claim 20-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 5,830,063. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-27 of the present application recite similar steps as claims 1-27 of the Patent.

4. Claims 20-27 of the present application recite "A method of playing a collateral wagering game in combination with a standard wagering game" while claims 1-27 of the Patent recite "A method of playing a gambling game.....and a collateral game".

5. Claims 20-27 of the present application recite the steps of "making a wager by a player on an outcome of the standard wagering game, with said player also participating in the collateral wagering game" and "allocating a prize value to the collateral wagering game based upon the winning outcome in the standard wagering game". These steps

are similar to the steps of "the amount invested by an individual player and a total amount invested by all players in the collateral game, said total amount invested being an amount invested by all players of the collateral game" in claims 1-27 of the Patent.

6. Claims 20-27 of the present invention recites the step of "determining whether the outcome of the standard wagering game comprises a winning outcome for said player, wherein a prize amount for the standard wagering game is determined when the winning outcome is achieved in the standard wagering game". This step is similar to "playing said gambling game, and if player receives a winning result, paying all players" recited in claims 1-27 of the Patent.

7. Claims 20-27 of the present invention recite the step of "paying said player said prize amount as determined in the standard wagering game and said total prize value for the collateral wagering game said player is entitled to receive". This step is similar to "paying all players that entered the collateral game related to the selecting of the winning result, a share of an available monetary award for said winning result" recited in claims 1-27 of the Patent.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 20-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones 553'.

The patent to Jones 553' discloses a method of playing a collateral wagering game, bonus game, in combination with a standard wagering game, poker game. The game may be played by a group of six players, col. 2, lines 56-61. To play Jones 553' game each player makes a wager in the ante area 14, on an outcome of the poker game with the player also participating in the bonus game, col. 3, lines 8-9. If a player achieves a winning outcome in the poker game, a prize amount, one-to one odds, is paid to the player, col. 4, lines 1-4. Each player that wants to continue playing the poker game places an additional wager or bet in the bet area 16, col. 3, lines 41-45. A prize value to the bonus game is allocated based upon the winning outcome in the poker game, see Bonus Payment Odds, col. 4, lines 15-24. If a player's winning outcome

exceeds a minimum win level, Two Pair or better, the player is paid a total prize value for the bonus game, see Bonus Payment Odds. The total prize value is determined by multiplying the prize value allocated (Bonus Payment Odds 2-to-1 to 250-to-1) by a number of winning shares (bet placed on bet area 16) the player has in the bonus game, col. 4, lines 5-24.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Celona.

The patent to Celona discloses a method of playing a collateral wagering game, jackpot game, in combination with a standard slot machine game. The game may be played by a group of players, col. 4, lines 16-18. To play Jones Celona's game each player makes a wager in the slot machine 104, col. 4, lines 18-20, on an outcome of the slot machine game. Each player also making an additional wager to participate in the jackpot game, col. 4, lines 21-25. If a player achieves a winning outcome in the slot machine game, a prize amount is paid to the player, col. 4, lines 38-42. A prize value to the jackpot game is allocated based upon the winning outcome in the slot machine

game, col. 4, lines 43-48. The player is paid a total prize value for the bonus game. The total prize amount for each player is based, at least in part, upon the individual prize amount for the slot machine game, col. 4, lines 48-56. Each player is paid the total prize amount each player is entitled to receive. The total prize amount for each player comprises adding the individual prize amount won by each player in the slot machine game to the prize value in the jackpot game multiplied by a number of winning shares owned by each of the players in the jackpot game, col. 4, lines 59 to col. 5, line 3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl